

REMARKS

Reconsideration of the rejections set forth in the Office Action mailed December 1, 2006, is respectfully requested. Claims 46-48 have been canceled without prejudice. Claim 49 remains pending in this application.

35 U.S.C. § 112

Claims 46-48 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Without conceding the propriety of the rejection, Applicants have canceled claims 46-48 without prejudice. Therefore, the rejection is now moot. Applicants respectfully request withdrawal of the rejection.

35 U.S.C. § 102

Claims 46-48 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Fisher (USP 6,350,244). Without conceding the propriety of the rejection, Applicants have canceled claims 46-48 without prejudice. Therefore, the rejections are now moot. Applicants respectfully request withdrawal of the rejections.

Claim 49 was rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Hirsch et al. (USP 5,395,319). Applicants respectfully assert that Hirsch does not teach or suggest “*a mass of solid particulate marker material disposed within the inner lumen,*” as required by the claims. The Examiner points to element numeral 10 in Figure 1 (see below) as being the “mass of solid particulate material.”

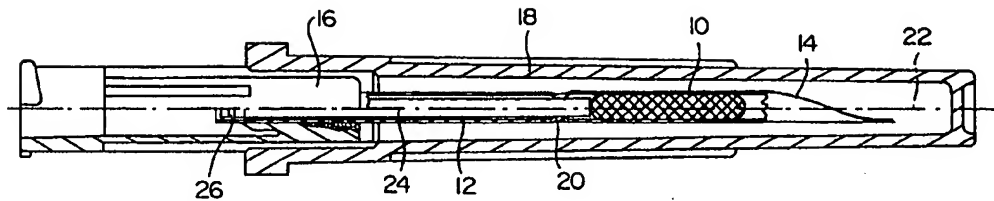


FIG. 1

The object being discharged from the needle, however, is described as being “designed as or can contain, for example, a long-term medicinal preparation, a capsule containing radioactive substances, or a metallic contrast element.” (Col. 4, lines 45-47; See also Col. 5, lines 15-17 “such as an identification carrier, a long-term medicinal preparation, contrast metal, or an encapsulated radioactive preparation.”) “Particulate” is defined as “of or relating to minute separate particles.” (www.m-w.com) Hirsch does not teach or suggest any such particulate material. As seen in Fig. 1, carrier 10 is always depicted and described as a single object. Therefore, Applicants respectfully request withdrawal of the rejection and reconsideration of the pending claim.

Information Disclosure Statement

In our previous response, Applicants noted that the non-patent literature references listed on the Forms PTO/SB/08A that were returned with the Office Action mailed October 25, 2005, were crossed out and not initialed. Although no explanation was provided for excluding these references, Applicants provided copies of all of the non-patent references and copies of previously submitted Forms PTO/SB/08A or 1449 with the Response filed on January 25, 2006, and respectfully requests consideration of these references that were previously submitted. These Forms PTO/SB/08 or PTO 1449 were submitted with Information Disclosure Statements filed on the following dates:

- July 20, 2004
- July 26, 2004

Additionally, Applicants request the acknowledgement and return of the Forms PTO/SB/08 or PTO 1449 from Information Disclosure Statements submitted on the following dates:

- December 12, 2003
- March 7, 2006
- August 29, 2006

Copies of these Information Disclosure Statements have been included for the Examiner's convenience. Applicants respectfully request that the Examiner review these Forms PTO/SB/08 or PTO 1449, initial the left-most column, and return initialed copies of the forms to the applicants.

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
O'MELVENY & MYERS LLP

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By: *Diane K. Wong*
Diane K. Wong
Reg. No. 54,550
Attorneys for Applicants

JCK/DKW/cp
O'Melveny & Myers LLP
610 Newport Center Drive, 17th Floor
Newport Beach, CA 92660-6429
(949) 760-9600